

Attorney Docket No. 103864.1101

Serial No. 09/512,734

REMARKS**I. Summary of the Office Action**

The Examiner objected to the application under 37 C.F.R. 1.172(a) as lacking proper written consent of all assignees owning an undivided interest in the patent. The Examiner found the reissue oath/declaration defective because it fails to identify at least one error, which is relied upon to support the reissue application. Further, the Examiner found the oath/declaration defective because it does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 C.F.R. 1.56. Claims 1-72 were rejected as being based upon a defective reissue declaration under 35 U.S.C. § 251.

II. Summary of Applicants Reply

Applicants have included amendments to the Statement under 37 C.F.R. 3.75(b), Assignee's Consent to Reissue, and Supplemental Declaration for Reissue Application.

a) Statement Under 37 C.F.R. 3.75(b) and Assignee's Consent to Reissue

The Examiner objected to the application under 37 C.F.R. 1.172(a) as lacking proper written consent of all assignees owning an undivided interest in the patent. Applicants have included the real and frame numbers for the assent of assignee. Further applicants have included the assignment of MERCK-MEDCO MANAGED CARE, INC to MEDCO HEALTH SOLUTIONS, INC.

Applicants submit that the Statement under 37 C.F.R. 3.75(b) and Assignee's consent to reissue are in condition for allowance.

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b) Supplemental Declaration for Reissue Application

The Examiner found the reissue oath/declaration defective because it fails to identify at least one error, which is relied upon to support the reissue application. Applicants have identified at least one error in the oath/declaration, which is relied upon to support the reissue application. For example, applicants have included, at least, the following statement reciting:

My original U.S. Patent 5,720,154 which matured from serial number 08/455,402, filed May 31, 1995, and which is continuation application of application Ser. No. 08/250,435, filed May 27, 1994, is partly inoperative or invalid by reason of claiming less than and more than I had the right to claim through error. In addition, this is a broadening reissue application.

Original claim 19 was too broad in reciting the limitation "to simultaneously count out and dispense pills." Claim 19 has been narrowed to recite "to simultaneously count out pills from said pill dispensers and sequentially dispense said counted pills."

Further, the Examiner found the oath/declaration defective because it does not state that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 C.F.R. 1.56. Applicants have included a statement that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 C.F.R. 1.56. For example, applicants have included, at least, the following statement reciting:

I/We hereby acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to be material to patentability as defined in 37 C.F.R. § 1.56.

Applicants respectfully submit that the Supplemental Declaration for Reissue Application is in condition for allowance.

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III. Declaration by Michael L. Mahar

Applicants respectfully indicate to the Examiner the previous waiver of 37 C.F.R. 1.172 granted on January 10, 2007. Applicants further attempted to contact Mr. Mahar to no avail. Attached please find the following evidence: a printout from 411.com indicating Michael Mahar's address; a letter to Mr. Mahar indicating the actions needed; and a FedEx tracking receipt indicating delivery of the letter to Mr. Mahar. Applicants respectfully submit that the previous waiver of 37 C.F.R. 1.172 granted still applies.

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CONCLUSION

Applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited prior art shows any of the elements recited in the claims. However, Applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

In addition, each of the combination of limitations recited in the claims includes additional limitations not shown or suggested by the prior art. Therefore, for these reasons as well, Applicants respectfully request withdrawal of the rejection.

Further, there is no motivation shown to combine the prior art cited by the Examiner, and even if these teachings of the prior art are combined, the combination of elements of claims, when each is interpreted as a whole, is not disclosed in the Examiner's proposed combination. As the combination of elements in each of the claims is not disclosed, Applicants respectfully request that the Examiner withdraw the rejections.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples Applicants have described herein in connection with

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distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicants are providing examples of why the claims described above are distinguishable over the cited prior art.

Applicants wish to clarify for the record, if necessary, that the claims have been amended to expedite prosecution. Moreover, Applicants reserve the right to pursue the original subject matter recited in the present claims in a continuation application.

Any narrowing amendments made to the claims in the present Amendment are not to be construed as a surrender of any subject matter between the original claims and the present claims; rather merely Applicants' best attempt at providing one or more definitions of what the Applicants believe to be suitable patent protection. In addition, the present claims provide the intended scope of protection that Applicants are seeking for this application. Therefore, no estoppel should be presumed, and Applicants' claims are intended to include a scope of protection under the Doctrine of Equivalents.

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Further, Applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintains the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, Applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

For all the reasons advanced above, Applicants respectfully submit that the rejections have been overcome and should be withdrawn.

For all the reasons advanced above, Applicants respectfully submit that the Application is in condition for allowance, and that such action is earnestly solicited.

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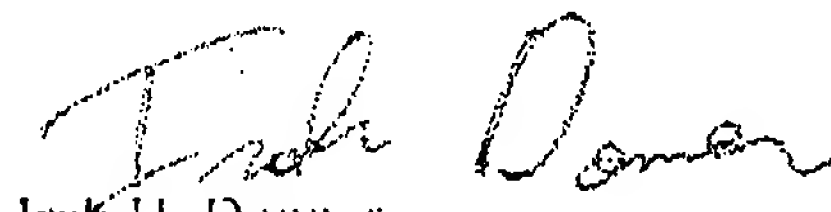
AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment to Deposit Account No. 08-0219

In the event that an Extension of Time is required, or which may be required in addition to that requested in a petition for an Extension of Time, the Commissioner is requested to grant a petition for that Extension of Time which is required to make this response timely and is hereby authorized to charge any fee for such an Extension of Time or credit any overpayment for an Extension of Time to Deposit Account No. 08-0219.

Respectfully submitted,

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